



RECEIVED

RECEIVED DEC

RSV
we

UNITED STATES PATENT AND TRADEMARK OFFICE

TC 1700

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,242	08/14/2000	Cali St. John	946-5	8391

7590 11/26/2003

Robert J Van Der Wall
First Union Financial Center Suite 4600
200 South Biscayne Boulevard
Miami, FL 33131-2310

EXAMINER

ROSSI, JESSICA

ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 11/26/2003

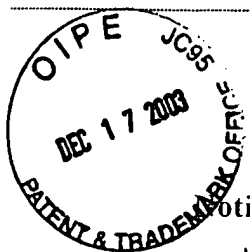
RECEIVED
DEC 23 2003
TC 1700

21

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE



RECEIVED

DEC 23 2003

TC 1700

COMMISSIONER FOR PATENT AND TRADEMARK OFFICE
P.O. BOX
ALEXANDRIA, VA 22313-4448
www.uspto.gov

Paper No.

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 11/10/03 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted. 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____
- ☐ 3. Amendments to the drawings: _____
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all claims (including withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: Claims 1, 3, 6, 12, 14, 16, 17 do not have the correct status identifier

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and this **ONE MONTH** time limit is not extendable.

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION** (including a submission for an RCE), and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. The period for response to a final rejection continues to run from the date set in the final rejection, and is not affected by the non-compliant status of the amendment.

Veronica Kay Everett (703) 308-2783
Legal Instruments Examiner (LIE) Telephone No.

IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

Applicant: Cali St.John Group Art Unit: 1733
Serial No.: 09/637,242 Examiner: Jessica L. Rossi
Title: BUSINESS METHOD FOR INDICIA WITH SANITARY BEVERAGE CAN
Filing Date: August 14, 2000
Attorney Docket No.: 946-5

AMENDMENT

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

In response to the Office Action dated April 25, 2003 and the
Advisory Action of August 5, 2003, please amend the above-
identified U.S. patent application as follows:

In the Claims:

Please enter amended claims 1, 3, 4, 15, 16, and 17, and add
new claims 18, 19 and 20 starting on the following page in
accordance with 37 C.F.R. § 1.121. Thereafter starting on a
separate page is the remarks portion in accordance with the 37
C.F.R. § 1.111.

1. (Thrice Amended) A business method relating to beverage containers having sealed apertures comprising:

conveying by profit making sale a right to attach indicia to consumer removed, ~~highly~~ flexible and ~~collectable~~ protective members to be adhered to the sealed beverage containers;

manufacturing the protective members;

applying indicia to the protective members; and

adhering the protective members to the sealed containers to form a substantially wrinkle free skin tight seal between the protective member and at least a portion of a mouth contact area of the beverage containers.

2. (Original) The method of claim 1 in which conveying the right to attach indicia to protective members to be adhered to beverage containers is achieved by selling the right to third parties.

3. (Thrice Amended) ~~The method of claim 1 in which~~ A business method relating to beverage containers having sealed apertures comprising:

conveying by profit making sale a right to attach indicia to consumer removed, flexible protective members to be adhered to the sealed beverage containers;

manufacturing the protective members, the protective members ~~are~~ being made in an hourglass configuration to facilitate adherence to a top and convex side of a container

without deformation and without wrinkling of a material of the protective member by folding it over a rim of a beverage can when adherence occurs;

applying indicia to the protective members; and
adhering the protective members to the sealed containers
to form a substantially wrinkle free skin tight seal between
the protective member and at least a portion of a mouth
contact area of the beverage container.

4. (Currently Amended) The method of claim 1 which further comprises sanitizing at least [[a]] the mouth contact portion of the containers.

5. (Original) The method of claim 1 in which the indicia is at least one of advertising, promotion, games of chance, premiums, collectibles, redeemables, merchandise acquisition means, prizes, public service announcements, instructional information, and warnings.

6. (Once Amended) The method of claim 1 wherein indicia is applied to the protective members by printing.

7. (Original) The method of claim 6 which further comprises treatment of the protective members to accept and retain printing ink.

8. (Original) The method of claim 7 in which the treatment

of the protective members is by corona discharge.

9. (Original) The method of claim 6 wherein the printing is applied to an underside of the protective members.

10. (Original) The method of claim 9 where the protective member is opaque so that the user cannot see the indicia until the protective member is removed.

11. (Original) The method of claim 10 where the underside printing and opaque protective member facilitates using the method for such things as games of chance, premiums, collectibles, redeemables, merchandise acquisition means, and prizes without a user knowing in advance of protective member removal which of a plurality of chances the user has obtained.

12. (Once Amended) The method of claim 1 wherein the protective members are adhered to containers using adhesive.

13. (Original) The method of claim 12 in which the adhesive is antibacterial.

14. (Once Amended) The method of claim 1 which further comprises imposing an anti-static chemical treatment on the protective member such that each one of the protective members will slide easily from an adjoining member and not cling to it under high speed dispensing.

15. (Currently Amended) The method of claim 1 which further comprises imposing chemical treatment on the protective member such that adhesive will bond more strongly to the member and less strongly to metal of the beverage container such that no adhesive residue is left on the container after removal of the protective member thus allowing the protective member to be adhered to other surfaces.

16. (Twice Amended) A business method relating to sealed beverage containers comprising:

conveying by profit making sale a right to attach indicia to consumer removed, ~~highly~~ flexible and ~~collectible~~ protective members to be adhered to a sealed beverage container[[s]];

manufacturing each protective member in an hourglass configuration to facilitate adherence to a top and convex side of a container without deformation and without wrinkling of a material of each protective member;

applying indicia to each protective member; and

adhering each protective member to a container including by folding each over a rim of a beverage can to form a substantially wrinkle free skin tight seal between the protective member and at least a portion of a mouth contact area of the beverage containers.

17. (Twice Amended) A business method relating to sealed beverage containers comprising:

conveying by profit making sale to a third party, a right to attach indicia to consumer removed, [highly] flexible [and collectable] protective members to be adhered to sealed beverage containers;

manufacturing the protective members;

applying indicia to opaque protective members by printing on the underside thereof to facilitate using the method for such things as games of chance, premiums, collectibles, redeemables, merchandise acquisition means, and prizes without a user knowing in advance of protective member removal which of a plurality of chances the user has obtained; and

adhering the protective members to the sealed containers to form a substantially wrinkle free skin tight seal between the protective member and at least a portion of a mouth contact area of the beverage containers.

18. (New) The method of claim 1, wherein the protective members when at least partially removed from the beverage containers are reattachable thereto.

19. (New) The method of claim 1, wherein the protective members are collectible.

20. (New) A sanitary cover for sealed beverage containers comprising:

a flexible protective member of suitable dimension to be adhered to the a mouth contact area and a seal of the beverage

container;

adhesive disposed on the protective member for adhering the protective member in a wrinkle free skin tight manner to the beverage container in the mouth contact area thereof, and substantially adhering to the protective member when the protective member is removed from the beverage container leaving substantially no adhesive residue on the mouth contact area and allowing for reattachment of the protective member to a surface; and

indicia disposed on protective member.

REMARKS

At the outset, Applicant would like to thank Examiner Rossi for the time and courtesy shown Applicant and his representative during the Examiner interview of May 8, 2003. In accordance with MPEP § 713.04, Applicant adopts the description of the substance of the interview by the Examiner in her Interview Summary dated May 8, 2003, except to add that the substance of the interview also considered that economics play a vital role for the present invention. Therefore, it is important in understanding the commercial viability of the present invention when compared to the prior art to recognize that nothing about the invention must interfere with the existing design of beverage containers, or the way they are filled at the bottling plant, or the way they are packaged, shipped and displayed for retail sale, and the cost cannot significantly affect product pricing. It was pointed out to the Examiner that the foregoing aspects provide an explanation for why none of the prior art is found in any supermarket. The design of the present invention complies with every one of the above criteria, as it must to enjoy the acceptance of the beverage industry that the present invention is now obtaining.

Turning to the Office Action, claims 1-17 are rejected under 35 U.S.C. § 112, 1st paragraph. Claims 1-2, 4-5, 12 and 14-15 are rejected under 35 U.S.C. § 103(a) over Ruemer, Granofsky, and the collective teachings of Blotky and Bozlee, or in the alternative, Granofsky in view of Ruemer. Claims 3 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Granofsky, Ruemer, and the collective teachings of Blotky and Bozlee and further in view

of Cummings. Claims 6, 9-11 and 17 stand rejected as being unpatentable over Ruemer, Granofsky and the collective teachings of Blotky and Bozlee and further in view of Bjornsen.

Claims 7-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ruemer, Granofsky, the collective teachings of Blotky and Bozlee and Bjornsen in view of Burns. Lastly, claim 13 stands rejected under 35 U.S.C. § 103(a) over Ruemer and Granofsky, the collective teachings of Blotky and Bozlee and further in view of Takayama.

In response to the Office Action, Applicant has amended claims 1, 3, 4, 15, 16, 17 and added new claims 18, 19 and 20. Reconsideration and reexamination of all claims is respectfully requested.

Before turning to the detail of the Applicant's responses to specific rejections in the Office Action, a few words are indicated about the efforts of Applicant to incorporate in this Amendment the areas that appeared to show some improved possibilities of allowability in the May 8, 2003 interview. As the Interview Summary shows, matters that were discussed included (1) the fact that the protective member effected a skin tight seal to the beverage container, (2) freedom from wrinkles, (3) the absence of adhesive residue left on the container when the protective member is removed, (4) reattachability of the protective member after its removal from the container, and (5) the benefits of the hourglass configuration. All of these areas have been addressed by amendments to independent or dependent claims, in the hope that the nonspecific progress made at the interview may result in one or

more areas on agreement and allowance. Specifically, items (1) and (2) above are addressed in all claims. Item (3) is addressed in claim 15 and new claim 20. Item (4) is addressed in new claims 18 and 20. Item (5) is addressed in claims 3 and 16.

Turning to the Office Action, claims 1-17 stand rejected under 35 U.S.C. § 112, 1st paragraph, for containing language not described in the specification. Specifically, the use of the term "highly" to modify the word "flexible" is objected to. Applicant submits that the term "highly flexible" is defined by the operational definition of the flexibility of the protective member in the specification. However, without conceding the correctness of the position of the Examiner, independent claims 1, 16 and 17 have been amended to delete the language "highly". Applicant submits that this is an amendment of form over substance and is not done to differentiate over the prior art of record. Accordingly, Applicant submits that the rejection of the claims under 35 U.S.C. § 112, 1st paragraph, has been obviated and respectfully requests the withdrawal of the rejection under 35 U.S.C. § 112, 1st paragraph.

Claim 4 has been amended to show dependency on a predicate added to claim 1.

Turning to the substantive rejections, in the Office Action, claims 1-2, 4-5, 12 and 14-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ruemer in view of Granofsky and the collective teachings of Blotky and Bozlee. Applicant respectfully traverses the rejection.

Applicant's invention as claimed, and as previously argued and

of the container itself, once it reaches the user, it can be removed and carried away so that in effect, the message on the indicia now becomes a mass market advertising medium much like a billboard. As the user carries the now removed protective member from location to location, it is converted from a media for a directed message to a media for mass broadcast of messages. In one embodiment, because it is adhered with a specially formulated type of adhesive, as defined in the dependent claims, the indicia can now be affixed to another surface, not necessarily the can, to act as a billboard. In this way, third parties are further enticed into purchasing the "broadcast rights" which have come with the rights to attach indicia to the protective member of the claimed invention. This new media provides a novel incentive for parties to purchase the rights to place their indicia on a protective member. These are advantages not enabled by any of the prior art as will be discussed below.

Turning particularly to claim 1, it defines a method for utilizing a consumer removed flexible protective member which is adhered to a sealed beverage container. The right to attach indicia to the protective member is conveyed by a profit making sale. The protective member is adhered to the sealed container to form a substantially wrinkle free skin tight seal between the protective member and at least a portion of a mouth contact area of the beverage container. As will be discussed below, nothing in the prior art teaches such a novel business method utilizing what is in fact a novel structure to provide novel commercial advantages to entice third parties to pay for the right to attach indicia to this

discussed with the Examiner, is a novel protective cover for a beverage can which forms a wrinkle free, skin tight seal between the protective member itself and at least a portion of the mouth contact area for already sealed beverage containers. Because of the wrinkle free, skin tight surface, the protective member provides an improved contamination barrier of simple construction that does not interfere in any way with the existing beverage industry. The surface of the protective member lends itself to the application of removable indicia which, in turn, lends itself to a novel business method for selling rights to an entirely new advertising media. Because the member is a flexible protective member which adheres to the sealed beverage container, it is an advertising media that utilizes a formally utilitarian structure (protective members) in a novel way, with a simple construction which facilitates easier application, easier removal, less complex structures, and less cost in manufacture and use as compared to the protective members of the prior art. Universally, the prior art protective structures do not create a new media, do not lend themselves to use as both a protective member and a simple mass marketing indicia, and generally do not avoid meddling with the status quo of the existing beverage industry.

Because the protective member is a flexible protective member which is adhered to the sealed beverage container, it includes indicia which can be directed to the specific limited audience of those people who purchase the product contained in the container. However, because the protective member forms a removable seal between the container and itself, and is not incorporated as part

protective member, and to do so with a beverage can.

Turning to the specific prior art, claim 1 is rejected over Ruemer which is considered to show protective member 10 for a beverage container as well as a flexible and collectible protective member and attaching promotional indicia to the protective member. It is conceded that the reference is silent as to conveying by profit making sale the right to attach indicia to the member. However, the protective member in Ruemer is not adhered to a sealed beverage container. In fact it is not a protective member. Element 10 of Ruemer is in reality the entire can top structure. It does not protect the can, it protects the contents of the can.

Because member 10 in Ruemer is the can top itself, there is no skintight seal, as defined in claim 1, protecting the top and keeping the mouth opening at 16 sanitary. This, of course, is a goal of the structure of claim 1 which will entice people to want to use the product, and entice others to pay for the right to attach indicia to the novel protective member.

If the structure in Figs. 4 and 7 of Ruemer are considered the protective member, they also do not form a seal between a sealed can and the protective member. They in effect seal the can. Part of the novel business method, is to protect the mouth contact area of a beverage can while providing a platform for carrying indicia in a removable manner, something not taught by Ruemer.

Granofsky suffers from the same deficiencies as Ruemer because what is considered the protective member is in fact the seal. In addition, in the one embodiment in which there is an additional seal in Granofsky, there is no teaching of the protective member

being wrinkle free and skin tight. Furthermore, at column 3, line 5, Granofsky teaches away from the claimed invention in that the "protective member" of Granofsky is not removable. A benefit of Granofsky is that you cannot remove the "protective member in order to avoid litter." This would be a disincentive to the profit making sale of the claimed invention because the sale is for the right to attach indicia to a consumer removed flexible protective members which are adhered to sealed beverage containers. Again, nothing in Granofsky teaches a wrinkle free skin tight seal. Therefore, not only would one not look to Granofsky to overcome the deficiencies of Ruemer, but would not look to Granofsky in trying to solve the problems of the claimed invention because the protective member of Granofsky teaches away from the claimed invention; the member is not removable.

As provided in MPEP § 2145 (XD) a prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness. Furthermore, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." In re Mills, 916 F.2d 680, 682; 16 U.S.P.Q. 2d 1430, 1432 (Fed. Cir. 1990). See also In re Fitch, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992). The interpretation of Granofsky and Ruemer used in the Office Action is in opposition to what they teach and therefore cannot be properly considered to suggest the argued modifications. There is no suggestion in either reference to modify the respective structures.

Blotky has no teaching to overcome the shortcomings of Ruemer

and Granofsky. There is no suggestion to convey any type of rights to an indicia which is removed, flexible and provides a substantially skin tight, substantially wrinkle free seal on a beverage container. Because of the complexity of Blotky, i.e., sensors and electronic circuits, it is affixed as a sleeve to the sides of the can. This complex structure does not lend itself for applying indicia to a protective member to form a substantially wrinkle free skin tight seal between the protective member and at least a portion of a mouth contact area of the beverage container. The complex circuitry in effect is a gross disincentive for one wishing to pay for the right to attach indicia to a consumer removed flexible protective member. The economics of Blotky render it nonanalogous art in the context of the present invention. Accordingly, the combination of Ruemer, Granofsky and Blotky does not in any way teach, describe or even suggest the claimed invention, nor is there an incentive in any one of the references taken individually to look to the other relied upon reference as solving a problem or adding a benefit which would result in the claimed invention.

Lastly, Bozlee is a reference from a totally unrelated field of art, and thus is another nonanalogous reference. Bozlee is directed to placing a sticky label around a handle of a shopping bag. It is not in any manner a protective member. It would not be obvious to one even skilled in the art to take the indicia properties of Bozlee directed to a handle and apply that sale of information to the sale of information on a consumer removed flexible protective member adhered to sealed beverage containers

where the protective member forms a substantially wrinkle free skin tight seal. There is no suggestion to look in the handle art as it would not solve any of the other concerns addressed by the business method of the claimed invention.

Turning to the specific arguments made in the Office Action, it is argued that it is known in the art to display advertising information on beverage and food containers related to other products made by the company selling the container as taught by Blotky. Even if the interpretation of Blotky is correct, as discussed above, nothing in Blotky teaches the method of selling that message on a removable flexible protective member for protecting the container with a substantially wrinkle free skin tight seal between the protective member and a portion of the mouth contact area. This provides not only a dual functionality of protection and providing indicia, something not contemplated by Blotky or, as discussed above in the other references, but provides advantages and structures which incentivize third parties to purchase the right to attach indicia as claimed. This is something not taught in Blotky which makes use of a complex messaging system not conducive to mass marketing, is not flexible, is grossly uneconomic in a field where economics are vital, and does not serve a protective function. Therefore, Blotky is inappropriately relied upon as being combinable with Ruemer and Granofsky and, even if combinable, does not overcome the shortcomings of both Ruemer and Granofsky or teach the novel business method of the claimed invention.

Bozlee is relied upon as teaching conveying a third party

right to advertise on a "sticker". Bozlee is nothing more than a miniature billboard. It is distinct from the claimed method of doing business in that the profit making sale is for the right to attach indicia to consumer removed flexible protective members to be adhered to sealed beverage containers. Bozlee in no way even suggests such a business method. Bozlee is directed to and teaches the unrelated business method of applying a sticker to a bag handle. It is an entirely different manner for targeting an audience or for enticing advertisers to purchase the right to attach indicia than the claimed invention. Accordingly, it is respectfully suggested that reliance on Bozlee for a general teaching is misapplied.

Ruemer is more particularly relied upon as teaching that the peripheral edge 14 of the protective member to the container is attached by flanging. Further, the attached flexible protective member 10, including a retractable tab portion, can be attached to container 11 using an adhesive as taught by Granofsky. However, Applicant respectfully submits that the flanging of member 10 further highlights that member 10 is not the protective member, but the can top itself. It does not protect the can or the mouth contact area as claimed. It is the protective member for the contents of the container because member 10 is the container itself. Furthermore, the reason flanging is used in containers is to make a rugged tight seal. Adhesive would not be utilized. Such a reading is hindsight invention, reading into the art as there is no suggestion in either of the references for the use of an adhesive to attach the container top to the side container.

Therefore, in light of these teachings, it would not have been obvious to one of ordinary skill in the art to use adhesive as an alternative to the flanging operation to attach the protective member of Ruemer to the container, especially an adhesive which makes the protective member removable. To do so would destroy the purpose for which member 10 is provided. It is respectfully submitted such a reading of a reference is inappropriate.

It is asserted in the Office Action, in the alternative, that it would have been obvious to attach promotional indicia to the flexible protective member of Granofsky because it is taught in Ruemer. However, Granofsky teaches away from consumer removable tops. It is not proper to combine references to negate a clear teaching of the references. Therefore, even if indicia were provided on the Granofsky top, because it cannot be consumer removed, it is not the business method as claimed. Accordingly, in light of the above, Applicant submits that claim 1 defines a method of doing business making use of novel structures in a novel way to perform the novel business method regarding conveyance of rights for profit on what is tantamount to a new media. Accordingly, Applicant respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

Claims 2, 4, 5, 12, 14, 15, 18 and 19 all depend from claim 1 and define the invention with greater particularity. Specifically, claim 2 defines that the right to attach indicia to the novel media of the protective member is sold to third parties. Claim 4 further defines the step of sanitizing at least the mouth contact portion. Claim 4 further highlights the primary nature of the media which is

a protective member and the keeping of a sanitary barrier by the skintight seal over a portion of the mouth contact area of the container. This is something not taught in any of the references discussed above. The primary references relied upon by the Examiner either form the mouth contact area or are not concerned with the mouth contact area. Furthermore, by sanitizing and providing the indicia at portion of the mouth contact area, the user of each can is forced to at least look at the indicia while removing it to drink the contents of the can. As admitted in the Office Action, Ruemer is silent as to sanitizing the mouth contact portion and although Granofsky teaches sanitizing the mouth contact portion, the seal itself is not removable thus teaching away from the claimed invention.

Claim 5 teaches the various types of indicia whereas claim 12 defines that the protective members are adhered to the containers using adhesive. However, because claim 12 incorporates the fact that the protective member is removable, it is the use of adhesive in a way that allows removal. This is something Granofsky teaches against and therefore Granofsky cannot be relied upon for making claim 12 obvious. MPEP § 2143.01. Claim 14 depends from claim 1 and includes the use of an anti static chemical treatment on the protective member to allow them to slide easily from an adjoining member to allow high speed manufacture. As admitted in the Office Action, the references, in particular Ruemer, are silent as to such treatment. It is respectfully suggested that the statement in the Office Action that it would have been obvious to treat such protective members in such a manner is hindsight invention. It is

well settled law that a blanket statement that something is within the skill of the art cannot support an obviousness rejection. MPEP § 2143.01, Ex parte Levengood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993), See also In re Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q. 2d 1313, 1318 (Fed. Cir. 2000). There is nothing anywhere in the prior art as properly applied to suggest that the treatment of such novel indicia for the claimed business method is obvious. Accordingly, Applicant submits that claims 2, 4, 5, 12, 14, 15, and 18-20 are allowable as defining patentable combinations in their own right as well as depending from allowable claim 1.

Claim 15 defines that the adhesive bonds more strongly to the member and less strongly to the metal beverage container. As a result, the adhesive remains with the protective member as it is removed. This, in effect, adds to the creation of the new advertising media of the claimed business method. The indicia, because it is attached to specific beverage containers, has a message which is initially targeted to the users of that specific beverage. This is a targeted message and it is the sale of the targeted message which is part of the business method. However, in addition to the novelty of the entire sale of specific rights as discussed above, because the adhesive remains with the protective member having the message on it, the protective member can now be attached to books, walls, and other publicly exposed surfaces not only to encourage collecting of the protective member by means of easy storage as claimed in claim 17, but also to convert the targeted message to a mass broadcast message. The indicia becomes a mass broadcast message because now the protective member has been

removed from the can which is directed solely to the purchasers of those beverages, to the cover of a book or other surface for public display, acting much like a billboard. In effect the removed protective member now has its own mobility and is in effect reborn as untargeted mass advertising in the same way as a highway billboard is.

As a result, the novel business method solves one of the old disadvantages of advertising. Advertisers often know that half of their budget is being misspent, they just don't know which half. Because of the claimed business method resulting in both direct and mass advertising, advertisers who purchase the rights can now make use of both targeted advertising and mass advertising to further maximize their advertising budget. This is a business method in which much of the advantage is derived from the adhesive as defined in claim 15. Not only is it mass advertising, but it is mass advertising that travels with the initial targeted user to further spread the message to the user's circle of contacts because the adhesive formulations allows attachment to surfaces other than the beverage container from which the consumer removed it. Claim 15 is rejected over Ruemer and state of the art. It is admitted that Ruemer is silent as to using "adhesive" of any sort. Ruemer relies on flanging and scoring to retain its structures intact. To state that it would have been obvious to one of ordinary skill at the time to use adhesive in Ruemer, which has no teaching of adhesive in the first place, so that it more strongly bonds to the member, which in effect is the can top, appears to be a hindsight conclusion. MPEP § 2143.01, Ex parte Levengood, In re Kotzab.

Accordingly, Applicant submits that claim 15 is allowable as defining a patentable combination in its own right as well as depending from allowable claim 1 and Applicant respectfully requests the withdrawal of the rejection of claim 15 under 35 U.S.C. § 103(a).

Claims 3 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Granofsky, Ruemer, and the collective teachings of Blotky and Bozlee and further in view of Cummings. Applicant respectfully traverses the rejection of Cummings.

Claim 3 defines that protective members are made in an hourglass configuration to facilitate attachment to a top and a side of the container over its rim without deformation and wrinkling. It is argued that Cummings because it shows an hourglass configuration would lend itself to Granofsky. Furthermore, the Office Action asserts that once the hourglass construction was known then it would also be known that it could be used to cover a lip with a protective member in a substantially wrinkle free manner without deformation. Cummings merely states that its shape encourages use of a pull tab connected to the closure. It is respectfully submitted that the fact that an hourglass shape can be used to accomplish protection of both the convex side of the container and a top of a container without wrinkling and deformation is first found in Applicant's specification. It is not an obvious teaching, if one must rely upon the teaching of the application itself to teach the prior art. MPEP § 2143, In re Vaeck, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991). Rather, the fact that the description of the

application is used, is evidence of novelty of the claimed invention and perhaps, an unexpected result of a preexisting structure, one definition of non-obviousness.

Furthermore, nothing in Cummings overcomes the shortcomings of Granofsky or any of the other references discussed with respect to claim 1. Accordingly, claim 3 is allowable over the prior art and Applicant respectfully requests the withdrawal of the rejection of claim 3.

Claim 16, defines a business method in which the right to attach indicia to a consumer-removed flexible protective member which is adhered to a sealed beverage container without deformation and without wrinkling of the material of each protective member. However, as discussed above in connection with claim 3, if one is relying on the description within the Applicant's own specification, then this is an inappropriate hindsight rejection. There is nothing in Cummings which overcomes the deficiencies of the other prior art constituting the rejection. Nor is there anything in Cummings which teaches the sale or the right to attach indicia to a consumer-removed flexible protective member for protecting a sealed beverage container. As discussed above with respect to claim 1, this is a novel business method based upon a novel use for the structure of a protective member not taught in the prior art. Accordingly, Applicant respectfully submits that claim 16 is allowable over the prior art and respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

Claims 6, 9-11 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ruemer, Granofsky, the collective teachings

of Blotky and Bozlee as applied to claim 1 above, and further in view of Bjornsen. Applicant respectfully traverses the rejection.

Claims 6 and 9-11 all depend from claim 1, either directly or indirectly, and define the novel business method with greater particularity. By way of example, claim 6 defines the method of applying the indicia as printing on the protective member. Claim 9 defines the indicia as being provided to the underside of the protective member while claim 10 further defines claim 9 as making the protective member opaque to hide the indicia to surprise the user of the container. Claim 12 defines the method as printing certain indicia in which it is disadvantageous to allow the user to see the indicia beforehand, such as contest prizes. Nothing in Bjornsen overcomes the shortcomings of Ruemer as discussed above. Accordingly, Applicant submits that claims 6 and 9-11 are allowable as defining patentable combinations in their own right as well as depending from allowable claim 1 and respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

Claim 17, much like claim 1, although not identical in scope, defines a business method of conveying the right to a second party to attach indicia to a consumer removed flexible protective member in which the indicia is applied to opaque protective members to the underside thereof and then adhering the protective member to the sealed container.

As discussed above in connection with Granofsky and Ruemer, neither of these teach the use of a removable protective member for protecting a sealed container in a removable manner to incentivize third parties to purchase the rights to place their indicia as

claimed. Nothing in Bjornsen overcomes these shortcomings. Applicant respectfully submits that claim 17 is allowable over the prior art and respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

Claims 7-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ruemer, Granofsky, the collective teachings of Blotky and Bozlee and Bjornsen, and further in view of Burns. Applicant respectfully traverses the rejection.

Claim 7 defines treatment of the protective members to accept and retain printing ink. In the Office Action it is conceded that Ruemer and Granofsky are silent as to treating the protective member to accept and retain ink. It is argued that treatment of the protective member would depend on the type of material used for the member which would dictate its ability to retain printing ink. However, Burns is cited as teaching the treatment of plastic closure members for beverage containers to prepare their surface for retaining printed matter. but there is nothing in Ruemer that indicates that it is made out of plastic. The material in Granofsky is merely described as a flexible sheet of material. It could just as easily be formed of rubber. Furthermore, there is nothing in either reference which would suggest such a modification, or need to combine with other teachings. The mere fact that references can be combined is insufficient. MPEP § 2143.01, In re Mills, 916 F.2d 680, 16 U.S.P.Q. 2d 1430 (Fed. Cir. 1990). Accordingly, it is hindsight invention to consider that the treating of plastic in Burns is even applicable to Ruemer and Granofsky. Even given this, claim 7 depends from claim 1. Nothing

in Burns overcomes the deficiencies of Ruemer and Granofsky as discussed above in connection with claim 1 and accordingly, Applicant submits that claims 7 and 8 are allowable as defining patentable combinations in their own right as well as depending from allowable claim 1 and respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a).

Claim 13 stands rejected as being unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Ruemer and Granofsky and the collective teachings of Blotky and Bozlee as applied to claim 1 and further in view of Takayama. Applicant respectfully traverses the rejection.

Claim 13 teaches the use of an adhesive which is antibacterial. This is to maintain the sanitized state of the protected area. Claim 13 depends from claim 12 and defines the invention with greater particularity.

In the Office Action, it is conceded that Granofsky is silent as to the adhesive being antibacterial. However, Takiyama is relied upon as teaching an antibacterial adhesive. The adhesive of Granofsky is not applied to maintain the seal as claimed. Rather, the adhesive is applied to make sure that the "protective layer" never leaves the container. The Granofsky member is in fact maintained in position on the can by tab 24 which holds it tightly about the side of the can, not the adhesive. Furthermore, Takiyama does not overcome the deficiencies of Granofsky in teaching the novel business method. Accordingly, Applicant respectfully submits that claim 13 is allowable as defining a patentable combination in its own right as well as depending from allowable claim 1.

Although Applicant believes that all the presently pending claims are now in condition for allowance, undersigned counsel remains available for a telephone interview if doing so will facilitate the resolution of any remaining technicalities, such as may be the proper subject of an Examiner's Amendment with the concurs of undersigned counsel. In the event such an interview would be of use, the Examiner is respectfully invited to telephone undersigned counsel at the telephone number listed below. Since the foregoing amendment of claims has resulted in four independent claims, a check for \$42.00 for the additional independent claim is enclosed.

Finally, the Examiner is invited to note that the address of undersigned counsel has changed, and to use the address listed below in the future.



CERTIFICATE OF MAILING

I HEREBY CERTIFY that the foregoing paper has been deposited this 3rd day of November, 2003 with the United States Postal Service with sufficient postage as first class mail in an envelope address to the Honorable Commissioner of Patents and Trademarks P.O. Box 1450, Alexandria, VA 22313-1450.

Respectfully submitted,

Robert J. Van Der Wall, Esquire
ROBERT J. VAN DER WALL, P.A.
Colonial Bank Centre
Suite 1620
1200 Brickell Avenue
Miami, Florida 33131
Telephone: 305-358-6000
Facsimile: 305-530-8880
E-mail: rjvpa@ix.netcom.com
Attorney for Applicant
Registration No. 28,125

C:\...\STJOHN\AMEND-4.005